

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte EDWARD F. HELINSKI

Appeal No. 2004-0328
Application No. 09/113,712

ON BRIEF

Before GARRIS, OWENS, and WALTZ, Administrative Patent Judges.
GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal which involves claims 1-11, 21 and 22. The only other claims in the application, which are claims 12-20, 23 and 24, stand withdrawn from further consideration by the examiner.

The subject matter on appeal relates to a punch and die alignment system or assembly. With reference to Figure 2 of the

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appellant's drawing, the here claimed invention comprises a punch 27, first and second dies 25 and 26 having first and second die apertures 40 and 50 as well as first and second housings 32 and 33 having first and second die receiving passages 35 and 34. The second die passage 34 is configured to permit at least one of the first die 25 and the second die 26 to rotate therein, thereby permitting the first die aperture 40 and the second die aperture 50 to be aligned with each other. This appealed subject matter is adequately represented by independent claim 1 which reads as follows:

1. A punch and die alignment system, comprising:

a first die including a first die aperture for receiving a punch;

a second die including a second die aperture for receiving the punch;

a first housing including a first die passage receiving at least a portion of the first die; and

a second housing including a second die passage receiving at least a portion of at least one of the first die and the second die, the second die passage being configured to permit at least one of the first die and the second die to rotate therein, thereby permitting the first die aperture and the second die aperture to be aligned with each other.

The references set forth below are relied upon by the examiner in the section 102 and section 103 rejections before us:

Kranik et al. (Kranik)	4,425,829	Jan. 17, 1984
Shimizu et al. (Shimizu)	5,214,991	Jun. 1, 1993

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Claims 1-3 and 6-8 are rejected under 35 U.S.C. § 102(b) as being anticipated by Kranik, and alternatively, these claims are rejected under 35 U.S.C. § 103(a) as being obvious over Kranik in view of Shimizu.

Finally, dependent claims 4, 5, 9-11, 21 and 22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kranik alone or Kranik in view of Shimizu.

For a complete exposition of the contrary viewpoints expressed by the appellant and by the examiner concerning the above noted rejections, we refer to the brief filed January 17, 2002 and to the answer mailed April 4, 2002.

OPINION

These rejections cannot be sustained for the reasons set forth below.

Each of appealed independent claims 1 and 6 requires the second die passage to be "configured to permit at least one of the first die and the second die to rotate therein, thereby permitting the first die aperture and the second die aperture to be aligned with each other." With respect to the 102 rejection of these claims, it is the examiner's position that the aforequoted claim limitation "is interpreted as defining the second die passage as being round thus permitting rotation

therein" and that "Kranik . . . meets this limitation in that the second die passage thereof (which receives component 48) is round" (answer, page 4). With respect to the section 103 rejection of these claims, it is the examiner's alternative position that "round dies fitted into round die passages are old and well known in the art as evidenced by Shimizu . . . and provide well known benefits including ease of manufacture and assembly" and that, "[t]herefore, it would have been obvious to one having ordinary skill in the art to make the second die passage as well as the second die of Kranik . . . round for the well known benefits including those described above" (answer, page 4). These positions of the examiner are fatally flawed in a number of ways.

In the first place, the examiner's position that Kranik's second die passage (and the die contained therein) is round lacks factual support. As correctly indicated by the appellant, Kranik contains no disclosure at all which supports the examiner's finding on this matter. It is therefore beyond dispute that this finding is mere conjecture on the examiner's part. We here remind the examiner that anticipation cannot be predicated on mere conjecture. See W.L. Gore & Assocs. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 314 (Fed. Cir. 1983); compare In

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re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967),
cert. denied, 389 U.S. 1057 (1968). For this reason alone, the
examiner's section 102 rejection cannot be sustained.

This section 102 rejection would be improper even if we were
to assume that the second die passage of Kranik is round.
Similarly, the examiner's section 103 rejection would be improper
even if we were to assume that it would have been obvious to
provide Kranik's second die passage with a round configuration in
view of Shimizu. This is because, again as correctly indicated
by the appellant, the mere existence of a round configuration, by
itself, does not support a conclusion that the second die passage
of Kranik would be capable of performing the functional
limitation of independent claims 1 and 6, namely, "to permit at
least one of the first die and the second die to rotate therein,
thereby permitting the first die aperture and the second die
aperture to be aligned with each other."

Concerning this last mentioned point, it is well settled
that an examiner must provide some evidence or scientific
reasoning to establish the reasonableness of the examiner's
belief that a functional limitation is an inherent or necessary
characteristic of the prior art. See Ex parte Skinner, 2 USPQ2d
1788, 1789 (Bd. Pat. App. & Int. 1986). Also see Ex parte Levy,

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17 USPQ2d 1461, 1463-64 (Bd. Pat. App. & Int. 1990). On the record before us, the examiner has proffered no evidence that a round configuration in Kranik's second die passage would permit rotation and thus the alignment function claimed by the appellant. At best, the examiner's argument in support of this proposition once again amounts to unacceptable conjecture. W.L. Gore & Assocs. v. Garlock, Inc., 721 F.2d at 1554, 220 USPQ at 314; In re Warner, 379 F.2d at 1017, 154 USPQ at 178.

The proposition advocated by the examiner not only lacks support in the appeal record, this proposition is actually undermined by the applied reference evidence. Specifically, the Shimizu reference, though showing that round die passages and dies were known in the prior art (e.g., see Figure 8), explicitly describes these dies as being "fixed" in their respective passages (e.g., see line 62 in column 7). This disclosure of a round die which is "fixed" in a round passage militates against the examiner's position that a round configuration would permit die rotation (and concomitantly the alignment function claimed by the appellant).

For the above stated reasons, we cannot sustain the examiner's section 102 and section 103 rejections of independent claims 1 and 6 or of the claims which depend therefrom. It

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